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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,669	12/19/2000	R. Allyn Forsyth	ELITRA.009A	7061

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EXAMINER

LU, FRANK WEI MIN

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,669

Applicant(s)

FORSYTH ET AL.

Examiner

Frank W Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-131 is/are pending in the application.
- 4a) Of the above claim(s) 1-44, 57-127 and 129-131 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-56 and 128 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12/19/2000 (original) is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-8, 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group XI, claims 45-56 and 128, SEQ ID No: 60, and species bacterial cells I in Paper No. 16 is acknowledged. The traversal is on the ground(s) that: (1) Applicant "traverse the restriction of elected Group XI from Group XVI" since "these claims may be examined together without serious burden because each claim flows from a single overarching concept. In particular, each claim flows from the single observation that *yidC* has been identified as an essential gene whose expression can be inhibited through the use of an antisense nucleic acid that is complementary to at least a portion of this gene, such as the elected antisense nucleic acid of SEQ ID No: 60." and "the examiner would only be required to search references which relate to the essentiality of the *yidC* gene."; and (2) applicant "traverse the separation of the antisense sequence of SEQ ID NO:60 from the polypeptide gene product of SEQ ID NO: 413 which is encoded by the gene of SEQ ID NO: 220.".

After carefully considered applicant's arguments, the examiner agreed to examine SEQ ID Nos: 60 and 413 together. However, the arguments have not been found persuasive toward the withdrawal of the restriction requirement of Groups XI and XVI nor persuasive toward the relaxation of same such that Groups XI and XVI will be examined together. First, Groups XI to XVI are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group XII such as a compound with activity against the product of a gene is not required for Group XI since the compound in Group XI can be a

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compound which does not reduce the activity or level of a gene product. Second, although applicant suggested that "the examiner would only be required to search references which relate to the essentiality of the *yidC* gene", this is not the reason for the restriction requirement. The main reason for the restriction is that these inventions are distinct and independent in that they are directed to methods which comprise different method steps. Third, since SEQ ID No: 220 is not found in elected Group XI and traversed Groups XII to XVI, SEQ ID Nos: 60, 413 and 220 will not be examined together.

The requirement is still deemed proper and is therefore made FINAL.

Sequence Rules Compliance

2. The sequencing listing in this application has complied with Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Claim Objections

3. Claim 45 is objected to because of the following informalities: SEQ ID NOs: 1-59 and 61-63 should be deleted since they was not elected by applicant.
4. Claim 55 is objected to because of the following informalities: SEQ ID Nos: 299-305, 312-315, 327-353, 357-364, 372-412, 414-458, 464-468, and 472-479 should be deleted since they was not elected by applicant.
5. Claim 128 is objected to because of the following informalities: claims 28, 38, 96, 99, and 110 should be deleted since they was not elected by applicant.

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Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 45-56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Note that claims 46-56 are dependent on claim 45.

8. Claim 45 is rejected as vague and indefinite because it is unclear how preamble corresponds to step (a). Note that, since applicant elected SEQ ID NO: 60, the examiner considered that an antisense nucleic acid in step (a) should be SEQ ID NO: 60. However, it is unclear that an antisense nucleic acid in step (a) mean SEQ ID No: 60 or mean any kind of antisense nucleic acid that is complementary to a nucleic acid encoding a gene and can reduce the activity or amount of said gene product. Please clarify.

9. Claim 52 is rejected as vague and indefinite in view of the phrase "contacting said cell with a concentration of inducer which induces said antisense nucleic acid to a sublethal level" because it is unclear what it intended. For example, does this phrase mean contacting said cell with an inducer in a concentration which induces said antisense nucleic acid to a sublethal level or does this phrase mean something else? Please clarify.

10. Claim 128 recites the limitation "claim 127" in the claim. There is insufficient antecedent basis for this limitation in the claim since claim 127 was not elected by applicant.

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Conclusion


11. No claim is allowed.
12. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

Frank Lu
September 6, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600